

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Kam-Wing Li

Art Unit: 2416

Serial No.: 10/728,657

Examiner: Nittaya Juntima

Filed: 12/05/2003

Confirmation No.: 1273

Title: BOUNDARY PROCESSING BETWEEN A SYNCHRONOUS NETWORK AND
A PLESIOCHRONOUS NETWORK

VIA EFS-WEB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Certificate of Electronic Transmission
Under 37 C.F.R. §1.8

I hereby certify that 10/638,920 this correspondence and any document referenced herein are being electronically filed with the USPTO via EFS-Web on January 6, 2010.

Michelle Wolf
(Printed Name of Person Sending Correspondence)

/Michelle Wolf/
(Signature)

APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST
FOR RECONSIDERATION UNDER 37 CFR § 1.705(b)

Sir:

This is a request for reconsideration of the patent term adjustment of 810 days indicated in the determination of Patent Term Adjustment under 35 U.S.C. § 154(b) that was attached to the Notice of Allowance mailed on October 6, 2009 for the above-referenced patent application. It is respectfully requested that Applicants be granted a minimum patent term adjustment of **1,070** days.

The issue fee is being paid concurrently herewith.

Applicants submit herewith a "Statement Under 37 CFR §1.705(b)(2)." In accordance with 37 CFR §1.705(b)(1), please charge the fee set forth in 37 CFR §1.18(e) (\$200.00) to Deposit Account No. 50-1047. Any other fees deemed to be due or credit for any overpayment should be directed to Deposit Account Number 50-1047 and authorization is hereby given to charge such account.

Respectfully submitted,
/Stuart H. Mayer/

Attorney for Applicant
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Stuart H. Mayer
Registration No. 35,277

Date: January 6, 2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Kam-Wing Li

Art Unit: 2416

Serial No.: 10/728,657

Examiner: Nittaya Juntima

Filed: December 5, 2003

Confirmation No.: 1273

Title: BOUNDARY PROCESSING BETWEEN A SYNCHRONOUS NETWORK AND
A PLESIOCHRONOUS NETWORK

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Michelle Wolf
(Printed Name of Person Sending Correspondence)

/Michelle Wolf/
(Signature)

STATEMENT UNDER 37 CFR § 1.705(b)(2)

Sir:

This statement is respectfully submitted in support of the “Application for Patent Term Adjustment Including Request for Reconsideration Under 37 CFR § 1.705(b)” for the above-referenced patent application. In view of the following, it is respectfully requested that Applicants be granted a minimum patent term adjustment of **1,070** days.

The patent term adjustment on the Determination of Patent Term Adjustment Under 35 U.S.C. § 154(b) (“PTAS Sheet”) that was attached to the Notice of Allowance and which is submitted herewith as Exhibit A is 810 days. That determination projected that the patent would issue on the Tuesday before the date that is 28 weeks after the October 6, 2009 mailing date of that notice (i.e., Tuesday, April 20, 2010).

This determination of 810 days is in error in that, pursuant to 35 U.S.C. §154(b), the Office failed to take certain action within the time frame specified in 37 CFR § 1.702(a) and failed to issue a patent within three years of the actual filing date of the above-referenced application in accordance with 37 CFR §1.702(b). See *Wyeth v. Dudas*, 88 U.S.Q.P. 2d 1538 (D.D.C. 2008). Applicants assert that pursuant to the decision in

Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), a PTO delay under 35 U.S.C. 154(b)(1)(A) overlaps with a delay under 35 U.S.C. 154(b)(1)(B) only if the delays occur on the same day.

The following is a statement of the facts involved specifying the correct patent term adjustment and the basis for the adjustment under 37 CFR § 1.702, including the relevant dates as specified in 37 CFR § 1.703(a)-(e) for which adjustment is sought, and the adjustment as specified in 37 CFR § 1.703(f) to which the patent is entitled, and any circumstances during the prosecution of the application resulting in the patent that constitutes a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 CFR § 1.704. Also, the application is not subject to a terminal disclaimer.

A. 14 Month Delay under 37 CFR §§ 1.702(a) and 1.703(a)

Pursuant to 37 CFR §1.702(a)(1) and 1.703(a)(1), Applicants are entitled to a period of patent term adjustment due to the failure by the Office to mail an action under 35 U.S.C. §132 not later than 14 months after the actual filing date (i.e., February 5, 2005) (hereinafter "14 Month Delay"). Applicants agree with the Office's calculation shown in Exhibit B that the 14 Month Delay is **902** days. Applicant agrees with the determination of 902 days by the United States Patent and Trademark Office.

B. 3 Year Delay under 37 CFR §§ 1.702(b) and 1.703(b)

The patentees are entitled to a period of patent term adjustment pursuant to 37 C.F.R. §§ 1.702(b) and 1.703(b) due to examination delay from the number of days in the period beginning on the day after three years (i.e., December 6, 2006) when the above-referenced application was filed under 35 U.S.C. § 111(a) (i.e., December 5, 2003) and ending on the date a patent is issued, not including several categories of exceptions stated in 35 U.S.C. § 154(b)(1)(B)(i)-(iii) ("3-Year Delay"). The patentees disagree with the Office's calculation shown in Exhibit A that the 3-Year Delay is 0 days (net of overlap; see infra); instead, the correct 3-Year Delay is **1233** days.

A patent is projected by the USPTO to issue on Tuesday, April 20, 2010, but may issue earlier or later, depending on the circumstances of publication. Assuming that a patent is issued on the projected issue date as indicated by the USPTO (i.e., April 20, 2010), said issue date would be 6 years and 138 (or 2328 days) after the date on which the above-referenced application was filed under 35 U.S.C. § 111(a), which, after accounting for the initial 3-year period, entitles the Applicant to Patent Term Adjustment of 3 years and 147 days, which is equivalent to **1233** days.

C. Exclusion of Overlapping Delay under 37 C.F.R. § 1.703(f)

Applicants are not entitled to a period of patent term adjustment to the extent that the periods in 37 CFR §1.702 (4 Month Delay) overlap pursuant to 37 CFR §1.703(f) (“Overlapping Delay”). The Office calculated **92** days of Overlapping Delay (Exhibit B). Applicants agrees with the Office's calculation.

D. Exclusion of Patent Term Adjustment after filing of Request for Continued Examination under 37 C.F.R. § 1.114

Applicant filed a Request for Continued Examination on April 10, 2008. Applicant acknowledges that they are not entitled to any Patent Term Adjustment after the date of filing a Request for Continued Examination, i.e., 2 years, 10 days or **740** days.

The Request for Continued Examination was filed after the application was pending for more than three years, on April 10, 2008, when the application was pending at the U.S. Patent and Trademark Office for 4 years and 128 days (or **1588** days). Applicant notes that they are not eligible for any Patent Term Adjustment after April 10, 2008. However, Applicant acknowledges they are not entitled to the time overlapping with the 14 month delay, i.e., from December 6, 2006 to July 27, 2007) or **233 days**.

G. Total Patent Term Adjustment

In accordance with the decision in *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), a PTO delay under 35 U.S.C. 154(b)(1)(A) overlaps with a delay under 35 U.S.C. 154(b)(1)(B) only if the delays occur on the same day. Thus, pursuant to 37 CFR §1.703(f), the total patent term adjustment is **902** days of 14 Month Delay, plus **1233** days of 3 Years Delay, minus **740** days after the filing of the RCE, minus **233** days that overlaps the 14 month delay, and minus **92** days of Applicant delay previously taken into consideration by the PTO for a total net Patent Term Adjustment of **1,070** days.

H. Conclusion

In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a patent term adjustment of **1,070 days**, which may be extended or reduced based on the actual date of issuance of a patent for the above-referenced application.

Respectfully submitted,

/Stuart H. Mayer/

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Date: January 6, 2010

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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/728,657

Filing or 371(c) Date:	12-05-2003	USPTO Delay (PTO) Delay (days):	902
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	92
Post-Issue Petitions (days):	+0	Total PTA (days):	810
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
10-06-2009	Mail Notice of Allowance		
10-02-2009	Notice of Allowance Data Verification Completed		
10-02-2009	Case Docketed to Examiner in GAU		
10-01-2009	Document Verification		
09-25-2009	Examiner's Amendment Communication		
09-16-2009	Date Forwarded to Examiner		
07-08-2009	Response after Non-Final Action		
04-08-2009	Mail Non-Final Rejection		
04-07-2009	Non-Final Rejection		
03-13-2009	Date Forwarded to Examiner		
03-11-2009	Request for Continued Examination (RCE)		
03-13-2009	Disposal for a RCE / CPA / R129		
03-13-2009	Date Forwarded to Examiner		
03-11-2009	Workflow - Request for RCE - Begin		
12-11-2008	Mail Final Rejection (PTOL - 326)		
12-11-2008	Final Rejection		
10-31-2008	Information Disclosure Statement considered		
10-31-2008	Reference capture on IDS		
10-31-2008	Information Disclosure Statement (IDS) Filed	59	
10-31-2008	Information Disclosure Statement (IDS) Filed		
10-31-2008	Workflow - Request for RCE - Begin		
10-06-2008	Date Forwarded to Examiner		
09-02-2008	Response after Non-Final Action		31
09-02-2008	Request for Extension of Time - Granted		
10-06-2008	Case Docketed to Examiner in GAU		
05-02-2008	Mail Non-Final Rejection		
04-28-2008	Non-Final Rejection		
04-15-2008	Date Forwarded to Examiner		
04-15-2008	Date Forwarded to Examiner		
04-10-2008	Request for Continued Examination (RCE)		
04-15-2008	Disposal for a RCE / CPA / R129		

-740
days

PTA stops

10/08/08

1233
3yr delay

04-10-2008	Workflow - Request for RCE - Begin	
04-08-2008	Mail Advisory Action (PTOL - 303)	
04-04-2008	Advisory Action (PTOL-303)	
03-21-2008	Date Forwarded to Examiner	
03-03-2008	Amendment after Final Rejection	
01-11-2008	Mail Final Rejection (PTOL - 326)	
01-07-2008	Final Rejection	
11-05-2007	Date Forwarded to Examiner	
10-29-2007	Response after Non-Final Action	2
07-27-2007	Mail Non-Final Rejection	902
07-23-2007	Non-Final Rejection	
04-27-2007	Case Docketed to Examiner in GAU	
01-18-2007	Case Docketed to Examiner in GAU	
11-16-2006	Case Docketed to Examiner in GAU	
07-28-2006	Case Docketed to Examiner in GAU	
03-21-2006	Case Docketed to Examiner in GAU	
09-14-2004	Case Docketed to Examiner in GAU	
05-07-2004	IFW TSS Processing by Tech Center Complete	
04-14-2004	Transfer Inquiry to GAU	
03-08-2004	Application Return from OIPE	
03-08-2004	Application Return TO OIPE	
03-08-2004	Application Return from OIPE	
03-09-2004	Application Is Now Complete	
03-08-2004	Application Return TO OIPE	
03-08-2004	Application Dispatched from OIPE	
03-09-2004	Application Is Now Complete	
12-05-2003	PGPubs nonPub Request	
02-11-2004	Cleared by OIPE CSR	
12-27-2003	IFW Scan & PACR Auto Security Review	
12-05-2003	Initial Exam Team nn	

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